

REMARKS

This Response is submitted in reply to the Office Action dated November 30, 2006. Claims 38, 39, 42-50, 81-101, 104, and 106 are pending. Claims 38, 42, 81, and 106 have been amended. No new matter has been introduced by these amendments.

A Petition for a Two-Month Extension of Time for filing this Response is submitted herewith. Please charge deposit account number 02-1818 for the Extension of Time and any other fees due in connection with this Response.

The Office Action objected to Claim 42 under 37 C.F.R. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Appropriate correction has been made, such that Claim 42 now depends from amended independent Claim 38.

The Office Action rejected Claims 38, 39, 42 to 50, 81 to 84, 90 to 101, 104 and 106 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,393,057 to Marnell ("Marnell") in view of U.S. Patent No. 6,398,645 to Yoseloff ("Yoseloff"), in further view of U.S. Patent No. 6,364,765 to Walker ("Walker"). Applicant respectfully disagrees with these rejections. Nonetheless, certain of the claims have been amended for clarification purposes.

The Office Action admits that Marnell does not disclose: (1) displaying a second group of cells and an associated second value payout while displaying the first group of cells and the associated first value payout, each cell in the second group of cells capable of being designated with the designator in response to any player of the plurality of players achieving an outcome in the second set of outcomes, wherein the designator indicates the gaming machine; and (2) apportioning at least one of the first value payout among a first plurality of players or the second value payout among a second plurality of players, wherein apportioning the first value payout or the second value payout comprises apportioning based on the number of designations of each gaming machine in the designated cells of the corresponding first group of cells or the second group of cells. The Office Action relies on Yoseloff and Walker to remedy these deficiencies in Marnell.

More specifically, the Office Action reasons that it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Marnell and Yoseloff since it is well-known to enable a player to play multiple bingo cards at once. The Office Action further asserts that it would have been obvious to modify Marnell to include the payout apportionment method taught by Walker as the inventions are in the same field of endeavor, i.e., the electronic gaming field wherein games comprise features designed to heighten player excitement and entertainment. The Office Action states that Marnell discloses dividing the bonus payouts among participants such that the participant who contributed the most obtains the greatest portion of the bonus payout. However, in Marnell, the person who contributes the most is the player with the most difficult poker hand. The Walker reference teaches that each player may receive a share of the bonus amount proportional to the game requirements achieved by that player. Thus, the Office Action concludes that awarding a player who has the greatest number of cells would have been an obvious variation of Marnell.

As a primary matter, the Office Action's motivation for combining the teachings of Marnell and Walker (i.e., the inventions are in the same field of endeavor) is not by itself sufficient to support a finding of obviousness. The Examiner must provide a reason for one skilled in the art to make such changes to Marnell. Applicant respectfully submits that the Office Action has not met this burden and, for this reason alone, the rejection should be withdrawn.

Moreover, in this case, the Office Action improperly uses hindsight reasoning by combining previously uncombined features from three separate references to conclude that a gaming device having the elements of amended independent Claim 38 is obvious. The Office Action is selectively picking elements from each of the three separate references without having a specific motivation to do so. This is an improper basis for the obviousness rejection.

Even assuming that it would have been obvious to modify Marnell in the manner proposed by the Office Action, the resulting method does not achieve the method of amended independent Claim 38.

First, unlike the method of amended independent Claim 38, the method resulting from the combination of Marnell, Yoseloff and Walker does not include a first value payout associated with only the first group of cells and displayed in association with only the first group of cells and a second different value payout associated with only the second group of cells and displayed in association with only the second group of cells.

In Yoseloff, the gaming device displays a plurality of bingo boards (i.e., groups of cells) associated with a game. The gaming device enables a player to wager on one or more bingo boards for each play of the game. The player can place equal wagers or different wagers on the selected bingo boards. If the player obtains a winning condition on any of the wagered-on bingo boards in the play of the game, the player wins an award based at least in part on the wager placed on that bingo board. In one embodiment, an optional display 144 (Col. 8, lines 5 to 9) displays the payout for the play of the game. Since a player can place different wagers on the each of the selected bingo boards, the award provided for each respective winning bingo board may be different. However, Yoseloff does not disclose displaying the awards or payout values that are individually associated with each of the bingo cards of the game. Rather, Yoseloff displays the payout for the entire play of the game, such as in the optional display area.

Accordingly, Yoseloff does not disclose a first value payout associated with only the first group of cells and displayed in association with only the first group of cells and a second different value payout associated with only the second group of cells and displayed in association with only the second group of cells. Walker also does not disclose these elements and, therefore, does not cure the deficiencies in Marnell.

In addition, unlike the method of amended independent Claim 38, Marnell does not disclose providing the first value payout if each of the cells in the first group of cells is designated, and providing the second different value payout if each of the cells in the second group of cells is designated. Rather, in the Marnell game, a payout is provided when a "bingo" occurs in the secondary game. A bingo occurs when "a predetermined pattern of spaces" on the bingo card are filled (Col. 8, lines 67 to 68). Marnell does not disclose that each of the spaces on the bingo card must be filled to trigger a payout.

On the other hand, the method of amended independent Claim 38 includes (1) a first value payout associated with only the first group of cells and displayed in association with only the first group of cells, and a second different value payout associated with only the second group of cells and displayed in association with only the second group of cells; and (2) providing the first value payout if each of the cells in the first group of cells is designated, and providing the second different value payout if each of the cells in the second group of cells is designated. It would not have been obvious to one of ordinary skill in the art to modify Marnell, in view of Yoseloff, in further view of Walker to result in such a method without reasonably being construed as improper hindsight reconstruction.

For at least the reasons discussed above, amended independent Claim 38 and the claims depending therefrom are each patentably distinguished over the combination of Marnell, Yoseloff and Walker.

Amended independent Claims 81 and 106 each include certain similar elements to amended independent Claim 38. For reasons similar to those discussed above with respect to amended independent Claim 38, amended independent Claims 81 and 106 and the claims depending therefrom are each patentably distinguished over the combination of Marnell, Yoseloff and Walker.

The Office Action rejected Claims 85 to 89 over Marnell in view of Yoseloff, in view of Walker, in further view of U.S. Patent No. 6,648,754 to Baerlocher. The patentability of amended independent Claim 81 renders these rejections moot.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such act is courteously solicited. If the Examiner has any questions regarding this response, Applicant respectfully requests that the Examiner contact the undersigned attorney.

Respectfully submitted,

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